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MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			EXAMINER WENDELL, ANDREW	
			ART UNIT	PAPER NUMBER
			2618	
			MAIL DATE	DELIVERY MODE
			04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/804,292

Applicant(s)

PECEN ET AL.

Examiner

Andrew Wendell

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1-10, 12-18, 20-27 and 29-34.  
Claim(s) withdrawn from consideration: \_\_\_\_\_

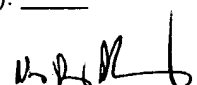
**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached office action.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

Andrew Wendell  
571-272-0557

  
NAY MAUNG  
SUPERVISORY PATENT EXAMINER

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4, 7-8, 18, 20, and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaheen et al. (US Pat Appl# 2004/0203792).

Regarding claim 1, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches a method in a communication device for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the method comprising entering an ongoing communication on the first radio access network UMTS (Fig. 7); detecting a presence of a second radio access network S6 (Fig. 7), the second radio access network being unregistered with the first radio access network at initial detection of the presence of the second radio access network while in the ongoing communication (Fig. 7 and Sections 0039-0043); and transferring the ongoing communication from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009 and 0039-0043), wherein the

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first radio access network is a cellular radio access network (UMTS) and wherein the second radio access network is a wireless local area network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 3, Shaheen teaches wherein the second radio access network is unregistered with the first radio access network by the first radio access network not initially having information on the second radio access network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 4, Shaheen teaches transmitting a measurement report including a fictitious neighbor value S7 and S8 (Fig. 7).

Regarding claim 7, Shaheen teaches setting up a data session with the second radio access network; and querying the second radio access network for information relevant to a circuit handover (Fig. 7).

Regarding claim 8, Shaheen teaches transmitting a message via a messaging service, the message including information on the second radio access network, the message indicating a desire to transfer the call from the first radio access network to the second radio access network (Fig. 7).

Regarding claim 18, Shaheen teaches a communication device for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the communication device comprising a transceiver (Fig. 7); a controller coupled to the transceiver, the controller configured to enter an ongoing communication on the first radio access network via the

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transceiver (Fig. 7); a network detection module configured to detect the presence of a second radio access network S6 (Fig. 7), the second radio access network being unregistered with the first radio access network at initial detection of the presence of the second radio access network while in the ongoing communication (Sections 0039-0043); and a handover module configured to transfer the ongoing communication from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009 and 0039-0043), wherein the first radio access network is a cellular radio access network UMTS (Fig. 7) and wherein the second radio access network is a wireless local area network WLAN (Fig. 7).

Regarding claim 20, Shaheen teaches wherein the second radio access network is unregistered with the first radio access network by the first radio access network not initially having information on the second radio access network when the network detection module detects the presence of the second radio access network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 24, Shaheen teaches wherein the controller is further configured to set up a data session with the second radio access network and query the second radio access network for information relevant to a circuit handover S9-S21 (Fig. 7).

Regarding claim 25, Shaheen teaches wherein the controller is further configured to transmit a message via a messaging service, the message including information on the second radio access network, the message indicating a desire to transfer the call from the first radio access network to the second radio access network (Fig. 7).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-6 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Boyer et al. (US Pat# 7,050,812).

Regarding claim 5, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches the limitations to claim 1. Shaheen fails to teach a color code.

Boyer's method in channel assignment in a cellular network teaches wherein the fictitious neighbor value includes one selected from the group of a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a color code as taught by Boyer into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to achieve a high degree of quality signals by minimizing the interference (Col. 2 lines 8-12).

Regarding claim 6, the combination including Boyer teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

Regarding claim 22, the combination including Boyer teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Regarding claim 23, the combination including Boyer teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

5. Claims 9 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Stumpert et al. (US Pat Appl# 2004/0157600).

Regarding claim 9, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches the limitations to claim 1. Shaheen fails to teach a short messaging service.

Stumpert's method for determining whether to grant access of a user equipment to a radio access network teaches wherein the messaging service is a short messaging service and wherein the message is a short messaging service message (Sections 0007, 0050, and 0054).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a short messaging service as taught by Stumpert into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to save money and be more efficient (Sections 0004-0005).

Regarding claim 26, the combination including Stumpert teaches wherein the messaging service is a short messaging service and wherein the message is a short messaging service message (Sections 0007, 0050, and 0054).

6. Claims 10, 16-17, 21, 27, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785).

Regarding claim 10, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches a method in a radio access network for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the method comprising recognizing an ongoing call of the communication device in a serving cell on the first radio access network (Fig. 7); receiving a measurement report S7 and S8 (Fig. 7) including an identifiable value associated with a serving cell of the first radio access network (Fig. 7); and transferring the call from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009



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and 0039-0043). Shaheen fails to teach a measurement report of the first radio access network.

Ovesjo's commanding handover between differing radio access technologies teaches a method in a radio access network for handover from a first radio access network to a second radio access network, the first radio access network using a different mode of communication from the second radio access network (Fig.1, Sections 0017-0020), the method comprising recognizing an ongoing call of the communication device in a serving cell on the first radio access network (Fig. 3); receiving a measurement report including an identifiable value associated with a serving cell of the first radio access network (Fig.3 and Sections 0032 and 0037-0038); and transferring the call from the first radio access network to the second radio access network (Fig. 3), wherein the identifiable value associated with the serving cell comprises a fictitious neighbor value (Fig.3 and Sections 0032 and 0037-0038).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a measurement report of the first radio access network as taught by Ovesjo into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to have additional parameters in a handover command without lengthening the command message (Section 0016).

Regarding claim 16, the combination including Shaheen teaches wherein transferring the ongoing communication from the first radio access network to the second radio access network comprises switching the connection between the

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communication device and the connected party via the first radio access network to a connection between the communication device and the connected party via the second radio access network (Fig. 7).

Regarding claim 17, the combination including Shaheen teaches wherein transferring the ongoing communication from the first radio access network to the second radio access network further comprises bypassing the first radio access network (Fig. 7).

Regarding claim 21, the combination including Ovesjo teaches wherein the controller is configured to enter a the ongoing communication by entering a call while operating in a serving cell of the first radio access network (Fig.1, Sections 0017-0020), and wherein the controller is further configured to generate and transmit a measurement report including a fictitious neighbor value associated with the serving cell (Fig. 3 and Sections 0032 and 0037-0038).

Regarding claim 27, Shaheen teaches a controller in a radio access network for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the controller comprising a communication connection module configured to connect an ongoing communication of the communication device in a serving cell on the first radio access network S2 (Fig. 7); a measurement report module configured to receive a measurement report (Fig.3 and Sections 0032 and 0037-0038); and a handover module configured to transfer the ongoing communication from the first radio access network to

the second radio access network (Fig. 3 and ). Shaheen fails to clearly teach a measurement report.

Ovesjo teaches a controller in a radio access network for handover from a first radio access network to a second radio access network, the first radio access network using a different mode of communication from the second radio access network (Fig.1, Sections 0017-0020), the controller comprising a communication connection module configured to connect an ongoing communication of the communication device in a serving cell on the first radio access network (Figs. 2 and 3); a measurement report module configured to receive a measurement report (Fig.3 and Sections 0032 and 0037-0038); and a handover module configured to transfer the ongoing communication from the first radio access network to the second radio access network (Fig. 3 and sections 0017-0020), wherein the measurement report comprises a fictitious neighbor value (Fig.3 and Sections 0032 and 0037-0038).

Regarding claim 33, the combination including Shaheen teaches wherein the ongoing communication is transferred from the first radio access network to the second radio access network comprises switching the connection between the communication device and the connected party via the first radio access network to a connection between the communication device and the connected party via the second radio access network (Fig. 7).

Regarding claim 34, the combination including Shaheen teaches wherein the ongoing communication is transferred from the first radio access network to the second radio access network further by bypassing the first radio access network (Fig. 7).

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7. Claims 12, 14, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785) and further in view of Boyer et al. (US Pat# 7,050,812).

Regarding claim 12, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in view of Ovesjo's commanding handover between differing radio access technologies teaches the limitations claim 10. Shaheen and Ovesjo fail to teach a color code.

Boyer's method in channel assignment in a cellular network teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a color code as taught by Boyer into a measurement report of the first radio access network as taught by Ovesjo into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to achieve a high degree of quality signals by minimizing the interference (Col. 2 lines 8-12).

Regarding claim 14, Boyer further teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

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Regarding claim 29, Boyer further teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Regarding claim 30, Boyer further teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

8. Claims 13, 15, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785) and further in view of Yahagi (US Pat# 7,065,360).

Regarding claim 13, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in view of Ovesjo's commanding handover between differing radio access technologies teaches the limitations in claim 10. The combination including Shaheen teaches wherein the second radio access network comprises a wireless local area network WLAN (Fig. 7) and the first radio access network comprises a cellular radio access network UMTS (Fig. 7). Ovesjo and Shaheen fail to teach the ongoing communication being a call.

Yahagi's multi-network communication system teaches wherein the ongoing communication comprises one of a data session and a call (Fig. 2 and Col. 4 lines 28-31).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate the ongoing communication being a call as taught by Yahagi into a measurement report of the first radio access network as taught by Ovesjo into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to make communication easier and receive different services (Col. 1 lines 32-35).

Regarding claim 15, Yahagi further teaches wherein the ongoing communication comprises a connection between the communication device and a connected party (Fig. 2 and Col. 4 lines 28-31).

Regarding claim 31, Yahagi further teaches wherein the ongoing communication comprises one of a data session and a call (Fig. 2 and Col. 4 lines 28-31).

Regarding claim 32, Yahagi further teaches wherein the ongoing communication comprises a connection between the communication device and a connected party (Fig. 2 and Col. 4 lines 28-31).

#### **Response to Arguments**

Applicant's Remarks	Examiner's Response
"There is no disclosure of a radio access network listening for wireless area network signals."	The claim does not state (or directly state) that the radio access network is listening for a wireless area network signals. A communication device can do the detecting of a signal as the claim reads.
"Furthermore, there is no disclosure of the	Applicant has failed to point out where in

<p>wireless local area network being unregistered with the radio access network."</p>	<p>Shaheen that it teaches the local area network is specifically registered with the UMTS network. Just because a WLAN is on a list S2 (Fig. 7) doesn't mean it is registered. The UMTS detects the presence of a WLAN and reports it on a list S2 (Fig. 7) to the UE to initiate S13 (Fig. 7, registering) and authenticate S14 (Fig. 7, registering) communication with the WLAN.</p>
<p>"There is absolutely no disclosure in Shaheen et al. and Ovesjo et al. of a fictitious neighbor value."</p>	<p>A fictitious value is a false value (doesn't have to be made up according to the definition). So, a bad reading or interference can lead to a false value. Examiner welcomes the applicant to amend the claims to further define a fictitious value (defining it to mean made up or fictional), but given the broadest reasonable interpretation of the claim limitations, Shaheen and Ovesjo teaches the claim limitations.</p>